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I hereby certify that this correspondence has been transmitted by facsimile number (703) 872-9306 to: Examiner Derrick G. Hamlin, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

April 23, 2004
Date

Sharanda Mozart
Signature - Sharanda Mozart

IN THE US PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
Benjamin Mosier, et al

DOCKET NO. 0468FV.44178

SERIAL NO.: 09/921,238

EXAMINER: Derrick G. Hamlin

FILED: August 2, 2001

ART UNIT: 1751

TITLE: Transesterification Composition of Fatty Acid Esters, and Uses Thereof

RESPONSE TO OFFICE ACTION RESTRICTION REQUIREMENT DATED 03/25/04

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the office action mailed March 25, 2004, Applicant provisionally elects Group I as defined by the Examiner. The Applicant makes this provisional election with traverse.

REMARKS

Applicant respectfully believes the restriction requirement is improper. The Examiner has stated in the office action that the basis for the restriction requirement is that "the process for using the product as claimed can be practiced with another materially different product." The Examiner has identified Group II and III as defining the process. Applicant respectfully points out that this is factually incorrect as each and every independent claim in Group II and Group III

requires the use of the composition of claim 2. Exemplary language from claim 58 from the Secondary Preliminary Amendment states "[a] process for lubrication of a lubricant-dependant system with a fluid comprising adding an effective amount of the composition of Claim 2 a ~~transesterified fatty acid ester~~ to the lubricant-dependant system in the fluid." This language is a reflection of the Secondary Preliminary Amendment filed with the U.S. Patent Office on August 15, 2003. Applicant believes that the Examiner has possibly reviewed the language of the first Preliminary Amendment filed in this case as opposed to the Second Preliminary Amendment. A copy of the Secondary Amendment is enclosed for the Examiner's convenience.

The Applicant has filed two Preliminary Amendments in the instant application. The Applicant is also filing a Petition to Make Special in this application based on the age of one of the inventors. It is noted that this application has been pending since 2001.

In summary, Applicant respectfully would show that the claims of Group II and Group III are tied to the claims of Group I in that the definition of the composition for use in the process claims is the composition defined in claim 2. The process, therefore, cannot be practiced without the use of the material of claim 2.


Applicant respectfully draws to the Examiner's attention that several Information Disclosure Statements have already been filed in this case, including material identified during the PCT search of the claims currently in prosecution. The previous amendments have already reduced the number of claims substantially and were submitted to largely harmonize the claims with the PCT claims. The search performed by the Examiner for the process claims will, necessarily, include the search also performed for the composition of claim 2 as this composition is specified in the process claims thereby tying the claims together.

Applicant also respectfully draws to the Examiner's attention the telephone call to K Baldauf over 4 months ago that is referenced on page 3 of the office action. K Baldauf is unknown to Applicant and Applicant's attorney. Please note that the Declaration and Power of Attorney filed indicates the attorney of record as Constance Gall Rhebergen and the members of Bracewell & Patterson, L.L.P. Further contact information is repeated below.

It is believed that this response addresses all issues raised in the office action. Removal of the restriction requirement and consideration of all of the claims as amended in the Second Preliminary Amendment is requested.

If the Examiner has any questions, a telephone conference is respectfully solicited at 713-221-3306.

Respectfully submitted,


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Date: April 23, 2004
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